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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/625,042 | 07/22/2003 | Remo Anton Hochstrasser | 21272 US | 1081 |

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HOFFMANN-LA ROCHE INC.
PATENT LAW DEPARTMENT
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NUTLEY, NJ 07110

EXAMINER

SIEFKE, SAMUEL P

ART UNIT PAPER NUMBER

1743

DATE MAILED: 12/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/625,042 | Applicant(s) HOCHSTRASSER ET AL. | |
| | Examiner Samuel P. Siefke | Art Unit 1743 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 9-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Claims 9-26 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Group II, III, and IV, V and VI, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 9/21/06. The traversal is on the ground(s) that there would not be a serious burden on the Examiner to examine all of the claims in the instant application. This is not found persuasive because a proper restriction was made in the Office Action dated 8/17/06 where each group was distinctly shown to be a different invention.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical

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Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-3, 5-6 and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by WO 01/50121 (herein after WO '121).

WO '121 discloses a method for removing a gelatinous material that comprises the steps of separating a gel cutting from the gel (page 2, lines 29-31), placing the cut gel in a new container (page 3, lines 28-32, page 5, lines 7-9) and covering the gel cutting with an equilibrating fluid (processing solution, page 10, lines 11-20). WO '121 states the processing fluid is pre-filled within the multi-well processing plate 32 and the gel fragment is placed therein. The Examiner is interpreting that when the gel is placed with in the processing plate containing the processing fluid, the gel is covered with the processing fluid after the gel is placed therein because the gel would sink or the user would submerge the cut gel so the processing fluid would cover the entire surface area of the cut gel. Regarding the cut gell having an edge that contours to the receiving processing fluid, it is the Examiner's interpretation that the cutting tip has a negative bevel which allows for easier excision of the spots, bands, or plaques from the gel 34. As seen in figure 3a-3e, the gel 34 is cut and a portion is removed and placed in the processing well 32. The gel conforms the inside of the processing well because it is smaller and has parallel sides that has the same contours of the well. Therefore the gel can be moved around within the processing well because there is a space between the

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gel and the sidewall of the processing well. WO '121 further states that different sizes of cutting can be cut out of the gel depending on the size of the spots, bands or plaques (page 10, line 33- page 11, line 9). If a larger spot were to be excised, the larger cutting would inherently consume the entire space in the processing well 32 and would thereby be immovably disposed therein.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

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the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 01/50121 (herein after WO '121) in view of Moi et al. (USPN 5,938,906).

WO '121 discloses a method for removing a gelatinous material as seen above.

WO '121 does not teach holding the gel in the processing well by clamping means or covering the gel with an equilibrating fluid before cutting.

Moi teaches a casting cassette for gel electrophoresis that comprises clamps for holding the gel within the container (fig. 5a-5d). It would have been obvious to one having an ordinary skill in the art at the time of the invention to modify WO '121 to employ a clamp to hold the cut gel in the processing well to prevent the gel cutting from moving around in the container and preventing unwanted movement therein. Regarding claim 7, it would have been obvious to one of ordinary skill in the art to modify WO '121 to cover the pre-cut gel with a processing fluid to prepare the gel for cutting. This is well known in the art of electrophoresis.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel P. Siefke whose telephone number is 571-272-1262. The examiner can normally be reached on M-F 7:00am-5:00pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on 571-272-1700. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Sam P. Siefke



December 11, 2006



Jill A. Warden
Supervisory Patent Examiner
Technology Center 1700